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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,738	01/09/2002	Wolfgang Brauer	Mo-6931/LeA 35,798	6549

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EXAMINER	
SERGENT, RABON A	
ART UNIT	PAPER NUMBER
1711	5

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

A9-5

Office Action Summary	Application No. 10/043,738	Applicant(s) Brauer et al.
	Examiner Rabon Sergent	Art Unit 1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *4*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to clearly identify component C). Applicants' name fails to encompass the ethoxy groups within the hydroquinone.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how auxiliary substances differ from accessory agents.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldwasser et al. ('834).

Patentees disclose a thermoplastic polyurethane derived from the reaction of diisocyanate, polyether polyol, and 1,4-di-(2,2'-hydroxyethoxy)-hydroquinone, in the presence of stannous octoate. See example 6-5 within Table I. Since the disclosed composition and instantly claimed composition are derived from equivalent reactants, the position is taken that applicants' claimed glass transition temperature is an inherent feature of the patentees' composition.

5. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwasser et al. ('834).

As aforementioned, patentees disclose thermoplastic polyurethanes, produced from reactants that meet applicants' reactants; however, the exemplified composition is silent with respect to the use of a prepolymer process and is further silent with respect to the use of an extruder. However, the position is taken that the use of both a prepolymer process and extrusion in the production of a thermoplastic composition was well known and conventional at the time of invention. This position is supported by the teachings of the reference at column 4, line 58+ and

column 11, line 45. Therefore, the position is taken that it would have been obvious to utilize such processing techniques to produce the exemplified composition.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pudleiner et al. ('939).

Patentees disclose the production of thermoplastic polyurethanes, wherein difunctional polyols, including polyether diols, and 1,4-bis(2-hydroxyethoxy)benzene are reacted with diisocyanates. Patentees further disclose the use of such catalysts as tin dioctoate. See columns 3 and 4.

7. Though patentees disclose additional reactants and catalyst species, the position is taken that it would have been obvious to select the claimed reactants and catalyst from the teachings of the patentees, so as to arrive at the instant invention, because one would have expected that the selection of virtually any of the disclosed reactants would have yielded a viable thermoplastic.

8. The examiner has considered applicants' remarks within pages 2 and 3 of the specification; however, the position is taken that applicants' claims are not commensurate in scope with the remarks. Applicants' claims do not exclude additional reactants.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

RABON SERGENT
PRIMARY EXAMINER

R. Sergent
September 30, 2002